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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,634	03/13/2002	Geoff S. Chalmers	18360/236825	3718

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EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/098,634	Applicant(s) CHALMERS ET AL.	
	Examiner James H Zurita	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I Claims 1-16, Drawn to a method of electronically providing a shipping label to a customer that wishes to return a good that was previously purchased from a merchant, Classified in class 705, Subclass 01
- II Claims 17-29, Drawn to a method of electronically providing a shipping label to a customer to return a good that was previously purchased from a merchant,, Classified in class 705, Subclass 28
- III Claims 30, Drawn to a method of electronically providing a shipping label to a customer to return a good that was previously purchased from a merchant, Classified in class 705, Subclass 26
- IV Claims 31-33, Drawn to a method of processing a return request from a customer that wishes to return a good that was previously purchased from a merchant, said, Classified in class 705, Subclass 28
- V Claims 34-48, Drawn to an electronic return shipping system, Classified in class 705, Subclass 26
- VI Claims 49-64, Drawn to an electronic return shipping system, Classified in class 705, Subclass 28

Group I (inventions I, II, III, IV) and Group II (Inventions V, VI) are related as process and apparatus for its practice. The inventions are distinct if it can be

shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case Group II requires the use of computers, while Group I may be performed manually.

Within Group I (inventions I, II, III, IV)

Inventions I And II Are related as Combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the combination as claimed because Invention I requires

Assigning a package tracking number to said return transaction;

The subcombination has separate utility such as

Formatting a label delivery link that is associated with said shipping label and includes a hypertext link to a uniform resource locator address;

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art ***as shown by their*** different classification, restriction for examination purposes as indicated is proper.

Inventions I And III Are related as Combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as

claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires

Assigning a package tracking number to said return transaction;

The subcombination has separate utility such as

Delivering said shipping label to a browser associated with said customer upon activation of said label delivery link.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art ***as shown by their*** different classification, restriction for examination purposes as indicated is proper.

Inventions I And IV Are related as Combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires

Assigning a package tracking number to said return transaction;

The subcombination has separate utility such as

Affixing said shipping label to a package containing said good to be returned; and Delivering said package to said merchant.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art **as shown by their** different classification, restriction for examination purposes as indicated is proper.

Inventions II And III Are related as Combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention II requires

Providing said customer with said label delivery link

The subcombination has separate utility such as

Providing said merchant with said label delivery link

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art **as shown by their** different classification, restriction for examination purposes as indicated is proper.

Inventions II And IV Are related as Combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention II requires

Art Unit: 3625

Formatting a label delivery link that is associated with said shipping label and includes a hypertext link to a uniform resource locator address;

The subcombination has separate utility such as

Taking said printed shipping label from said carrier facility to said customer;
Affixing said shipping label to a package containing said good to be returned; and
Delivering said package to said merchant.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by Recognized Divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions III And IV Are related as Combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention III requires

Formatting a label delivery link that is associated with said shipping label and includes a hypertext link to a uniform resource locator address; and Providing said merchant with said label delivery link;

The subcombination has separate utility such as

Printing said shipping label at a carrier facility; Taking said printed shipping label from said carrier facility to said customer; and affixing said shipping label to a package containing said good to be returned;

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by Recognized Divergent subject matter, restriction for examination purposes as indicated is proper.

Within Group II (inventions V, VI)

Inventions V And VI Are related as Combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention II requires

online return application is further configured to electronically deliver said shipping label to said customer.

The subcombination has separate utility such as

online return application is further configured to format and send a label delivery link that is associated with said shipping label and includes a hypertext link to a uniform locator address.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by different classification, restriction for examination purposes as indicated is proper.

This application also contains claims directed to the following patentably distinct species of the claimed invention:

If applicant chooses Invention I, the applicant must select one of the following species.

I.a	1, 2	I.h	1, 9
I.b	1, 3	I.i	1, 10
I.c	1, 4	I.j	1, 11, 12
I.d	1, 5	I.k	1, 11, 13
I.e	1, 6	I.l	1, 14
I.f	1, 7	I.m	1, 15
I.g	1, 8	I.n	1, 16

If applicant chooses Invention II, the applicant must select one of the following species.

II.a	17, 18	II.g	17, 24
II.b	17, 19	II.h	17, 25
II.c	17, 20	II.i	17, 26
II.d	17, 21	II.j	17, 27
II.e	17, 22	II.k	17, 28
II.f	17, 23	II.l	17, 29

If applicant chooses Invention III, the applicant must select one of the following species.

III.a	34, 35	III.h	34, 42
III.b	34, 36	III.i	34, 43
III.c	34, 37	III.j	34, 44
III.d	34, 38	III.k	34, 45
III.e	34, 39	III.l	34, 46
III.f	34, 40	III.m	34, 47
III.g	34, 41	III.n	34, 48

If applicant chooses Invention VI, the applicant must select one of the following species.

IV.a	49, 50	IV.g	49, 57
IV.b	49, 51	IV.h	49, 58
IV.c	49, 52	IV.i	49, 59
IV.d	49, 53	IV.j	49, 60, 61
IV.e	49, 54, 55	IV.k	49, 60, 62, 63, 64
IV.f	49, 56		

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 17, 34 and 49 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a

claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 10/098,634
Art Unit: 3625

10
Page 4

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ
James Zurita
Patent Examiner
Art Unit 3625
10 March 2005


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